

### **REMARKS**

In the Office Action, the Examiner rejected claims 1-33 and 36-59. By the present response, Applicants amended claims 1, 20, 31, 32, 43, 45-47 and 51 and added new claims 60-62 to clarify certain aspects of the claimed subject matter. Accordingly, the Applicants respectfully request that the Examiner enter these amendments and reconsider the present application in view of the following remarks.

#### **Interview Summary**

In a telephonic interview on July 12, 2004, Applicants' representative Tait Swanson (Reg. No. 48,226) discussed the claims in the present application with Examiner Anatoly Vortman (AU 2835). Specifically, the Examiner asserted that the claim term "footprint" does not convey sufficient structure. Applicants' representative stressed that the claim recitations clearly correlate the term footprint to the base structures in the various claims. However, the Applicants' representative proposed several alternative phrases, such as bottom mounting surface and base geometry, instead of the term footprint. The Examiner agreed that these alternative claim recitations would more clearly convey the structural features in the present claims. In addition, Examiner indicated a dislike for functional language in the format of "adapted to," but asserted that the phrase "configured to" would be more favorable. The parties agreed to the foregoing changes as further clarifying the present claims, yet the parties did not reach an agreement regarding the prior art.

#### **Claim Rejections – 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected claims 1-59 under U.S.C. § 112, Second Paragraph as indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. Specifically, the Examiner objected to the terms "footprints," "footprint," "reduced footprint," and "different footprints" recited *inter alia* by independent claims 1, 20, 32, 43, and 51.

***Legal Precedent***

Although the Examiner may take exception to the terms used in the claims, the patentee may be his own lexicographer. *Ellipse Corp. v. Ford Motor Co.*, 171 U.S.P.Q. 513 (7<sup>th</sup> Cir. 1971), *aff'd*. 613 F.2d 775 (7<sup>th</sup> Cir. 1979), *cert. denied*, 446 U.S. 939 (1980). Additionally, Applicants remind the Examiner that certain claim elements have inherent features, such as surfaces, which do not require prior introduction or disclosure to meet the requirement of antecedent basis. For example, the limitation “the outer surface of said sphere” would not require an antecedent recitation that the sphere has an outer surface. *See Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 U.S.P.Q.2d 1216, 1218-19 (Fed. Cir. 2000).

***Claims 1-59***

Although Applicants disagree with the Examiner’s rejection, the Applicants removed the “footprint” terms in favor of alternative claim recitations as set forth in the amended claims. Applicants believe that these claim amendments should remove the Examiner’s objections without narrowing the scope of the instant claims. In view of the foregoing amendments and remarks, Applicants respectfully request withdrawal of the rejections under Section 112, Second Paragraph.

**Rejections Under 35 U.S.C. § 102**

The Examiner rejected claims 1-7, 11-17, 20-24, 27-33, 36-47, 49-56, 58, and 59 under 35 U.S.C. §102(b) as anticipated by Helot et al.

***Legal Precedent***

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails

to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

If the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.*

Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (CCPA 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

### ***Independent Claim 1***

As shown in the listing of claims, amended independent claim 1 recites multiple structures configurable with multiple *base geometries configured to rest on a supporting surface during operation*, wherein *at least two* sections are configured to house *electronic*

*components*. Accordingly, the Applicants respectfully stress that Helot et al. is absolutely devoid of the sections and multiple base geometries, as recited in independent claim 1.

The Applicants stress that in view of the Examiner's misconception that a footprint includes an outline or shadow of a structure, rather than positioning of the actual structure on a surface, the Applicants amended claim 1 to clearly recite a structural aspect, "base geometries." Further, the Applicants amended independent claim 1 to recite the base geometries as *configured to rest* on a surface. Therefore, the Applicants assert that the Helot et al. reference is absolutely devoid of any teaching or suggestion of different base geometries as recited in claim 1. In fact, Helot et al. disclose only *one invariable base* 22 mountable on a surface. See Helot et al., Figs. 1, 8, 10, 11.

The Helot et al. reference clearly lacks the *at least two* component housing sections *configured to house electronic components*, as recited in the instant claims. Turning to Helot et al., the only portion of the computer 20 adapted to house components is the computer base 22. See Fig. 3 and col. 4, lines 24-26. In the Office Action, the Examiner equated the computer base 22 (which contains a keyboard 21) and the first arm member 42 (which contains a hinge assembly 27) to the *at least two* component housing sections recited in the instant claims. See Paper 15, page 4. The Examiner argued that arm section 42 houses components of the hinge assembly 27. See *id.* The Applicants stress that Helot et al. do not disclose the arm section 22 as *housing* the hinge assembly 27, but rather the hinge assembly 27 provides an *intermediate connection* between the arm section 22 and the computer base 22. See Helot et al., Col. 2, lines 38-40 and 58-60. Therefore, the Helot reference fails to teach or suggest the *at least two* component housing sections, as recited by the instant claims.

In view of these missing elements, independent claim 1 and its respective dependent claims are believed to be patentable over Helot et al. Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 102 and allow the foregoing claims.

***Independent Claim 20***

As shown in the listing of claims, amended independent claim 20 recites a multi-sectional housing configurable with *first and second undersides configured to contact a supporting surface during operation*. Accordingly, the Applicants respectfully stress that Helot et al. is absolutely devoid of first and second undersides, as recited in independent claim 1.

The Applicants stress that in view of the Examiner's misconception that a footprint includes an outline or shadow of a structure, as discussed above, the Applicants amended claim 20 to clearly recite a structural aspect, i.e., first and second undersides. Further, the Applicants amended independent claim 20 to recite that the undersides are "*configured to contact a supporting surface*." Therefore, the Applicants assert that the Helot et al. reference is absolutely devoid of any teaching or suggestion of first and second undersides as recited in claim 20. In fact, Helot et al. disclose only *one invariable base 22* mountable on a surface. See Helot et al., Figs. 1, 8, 10, 11.

In view of these missing elements, independent claim 20 and its respective dependent claims are believed to be patentable over Helot et al. Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 102 and allow the foregoing claims.

***Independent Claim 32***

As shown in the listing of claims, amended independent claim 32 recites a computer structure with at least four sections comprising *at least two component housing sections* configured to support *computing components* and configurable with at least two different *foundations configured to rest on a surface during operation*. Accordingly, the Applicants respectfully stress that Helot et al. is absolutely devoid of different foundations, as recited in independent claim 32.

The Applicants stress that in view of the Examiner's misconception that a footprint includes an outline or shadow of a structure, the Applicants amended claim 32 to clearly recite a structural aspect, "foundations." Further, the Applicants amended independent claim

32 to recite the *foundations as configured to rest* on a surface. Therefore, the Applicants assert that the Helot et al. reference is absolutely devoid of any teaching or suggestion of different foundations as recited in claim 32. In fact, Helot et al. disclose only *one invariable base 22* mountable on a surface. See Helot et al., Figs. 1, 8, 10, 11.

Additionally, the Helot et al. reference clearly lacks the *at least two* component housing sections *configured to support computing components*, as recited in the instant claims. As discussed above, the only portion of the computer 20 adapted to house components in Helot et al. is the computer base 22. Accordingly, the Helot reference fails to teach or suggest *at least two* component housing sections, as recited by the instant claims.

In view of these missing elements, independent claim 32 and its respective dependent claims are believed to be patentable over Helot et al. Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 102 and allow the foregoing claims.

#### ***Independent Claim 43***

As shown in the listing of claims, amended independent claim 43 recites a method comprising supporting a plurality of panels configured for computing components, a display panel and an intermediate member in a plurality of rotated configurations *having different bottom mounting surfaces*, each of the *bottom mounting surfaces configured to be seated on a surface*. Accordingly, the Applicants respectfully stress that Helot et al. is absolutely devoid of different foundations, as recited in independent claim 43.

The Applicants stress that in view of the Examiner's misconception that a footprint includes an outline or shadow of a structure, the Applicants amended claim 32 to clearly recite a structural aspect, "bottom mounting surfaces." Further, the Applicants amended independent claim 32 to recite the *bottom mounting surfaces as configured to rest* on a surface. Therefore, the Applicants assert that the Helot et al. reference is absolutely devoid of any teaching or suggestion of bottom mounting surfaces as recited in claim 43. In fact, Helot et al. disclose only *one invariable base 22* mountable on a surface. See Helot et al., Figs. 1, 8, 10, 11.

In view of these missing elements, independent claim 32 and its respective dependent claims are believed to be patentable over Helot et al. Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 102 and allow the foregoing claims.

***Independent Claim 51***

As shown in the listing of claims, amended independent claim 51 recites a method comprising orienting sections of a multi-configurable computing device to a plurality of different base sizes, each of the plurality of different base sizes *configured to rest on a supporting surface*. Accordingly, the Applicants respectfully stress that Helot et al. is absolutely devoid of different base sizes, as recited in independent claim 51.

The Applicants stress that in view of the Examiner's misconception that a footprint includes an outline or shadow of a structure, the Applicants amended claim 32 to clearly recite a structural aspect, "base sizes." Further, the Applicants amended independent claim 32 to recite the base sizes as *configured to rest* on a supporting surface. Therefore, the Applicants assert that the Helot et al. reference is absolutely devoid of any teaching or suggestion of different base sizes as recited in claim 43. In fact, Helot et al. disclose only *one invariable base* 22 mountable on a surface. See Helot et al., Figs. 1, 8, 10, 11.

In view of these missing elements, independent claim 51 and its respective dependent claims are believed to be patentable over Helot et al. Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 102 and allow the foregoing claims.

**Rejections of Dependent Claims Under 35 U.S.C. § 103**

The Examiner rejected *dependent* claims 8-10, 18, 25, 26, and 57 under 35 § U.S.C. §103(a) as unpatentable over Helot et al. in view of Karidis (U.S. Patent No. 6,006,243). The Examiner also rejected dependent claims 19 and 48 under 35 § U.S.C. §103(a) as unpatentable over Helot et al. in view of Stern (U.S. Patent No. 5,260,884). Applicants respectfully traverse the Examiner's rejections.

### ***Legal Precedent***

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (P.T.O. Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

Second, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Third, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); see M.P.E.P. § 2143.01.



***Deficiencies of the Cited References***

Applicants respectfully traverse the foregoing rejections for a number of reasons. First, all of the claims subject to this rejection under 35 U.S.C. § 103 are dependent on one of independent claims 1, 20, and 51, which are believed to be patentable over the Helot et al. reference for the reasons set forth above. Second, neither Karidis nor Stern obviates the deficiencies of Helot et al. For example, none of the cited references teach or suggest a plurality of *different base geometries configured to rest on a supporting surface during operation*, as recited by foregoing independent claim 1. Accordingly, the foregoing dependent claims 8-10, 18, 19, 25, 26, 48, and 57 are believed to be patentable over the Helot et al., Karidis, and Stern references taken alone or in combination. For these reasons, Applicants respectfully request that the Examiner withdraw the rejections of claims 8-10, 18, 19, 25, 26, 48, and 57 under 35 U.S.C. § 103.

**Conclusion**

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Applicants kindly invite the Examiner to contact the Applicants' attorney, Tait R. Swanson (Reg. 48,226), at the telephone number indicated below.

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Respectfully submitted,



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